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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,864	01/18/2002	Yasushi Yamamoto	358.41077X00	9239

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EXAMINER
KING, BRADLEY T

ART UNIT	PAPER NUMBER
3683	

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/050,864	Applicant(s) YASUSHI	
	Examiner Bradley T King	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) *3 and 5-7* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Applicant's election of Species I, Sub Species A in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 3, and 5-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species or sub species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Please remove the "means" language.

Claim Rej ctions - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a shift lever support member that is disposed in said casing so as to slide in an axial direction and supports said shift lever". The shift lever of the elected embodiment appears to correspond to element 34. The shift lever support member appears to correspond to element 35 which is integral with the shift lever 34. The claim language appears to indicate that the shift lever and shift lever support member are two separate elements.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter (US# 5743143) et al in view of Bovina et al (US#6382042).

Carpenter et al disclose a gear shift device including: a select actuator 116, a shift actuator 106, wherein the select actuator comprises a casing, a shift lever support

member 188 that is disposed in the casing so as to slide in an axial direction and support the shift lever. Carpenter et al lack magnetic moving means disposed on the outer periphery of the shift lever support member, a cylindrical fixed yoke surrounding the magnetic moving means, and a coil disposed on the inside of the fixed yoke. Carpenter et al instead disclose hydraulic or electric motors to actuate the shift device. Bovina et al teach a similar gear shift device and further suggest the substitution of a electro magnet actuator in place of a hydraulic actuator (column 6, lines 62-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize an electromagnetic actuator such as taught by Bovina et al in place of the hydraulic or motor actuators of Carpenter et al, thereby eliminating the hydraulic control system and simplifying the device. It further would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the actuator the outer periphery of the shift lever support member as an obvious means of implementing the device. Note Carpenter et al also teach a magnetic position sensor which is located on the outer periphery of the support member.

Regarding claim 2, see figure 5a of Carpenter et al.

Regarding claim 8, see figure 5a of Carpenter et al. Channel 234 limits movement.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter et al and Bovina et al as applied to claim 1 above, and further in view of Lequesne (IEEE article).

Carpenter et al and Bovina et al, as applied to claim 1 above, disclose all the limitations of the instant claims with exception to the specific features of the actuator (two coils and the permanent magnets). Such construction is well known in the art and further illustrated by Lequesne (see figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utlize a magnetic actuator structure such as known in the art and illustrated by Lequesne in the gear shift device of Carpenter et al and Bovina et al as an obvious means of implementation and further insuring proper actuation in both directions. (see page 402, column 1, last paragraph of Lequesne).

Double Patenting

Claims 1 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Applications No. 10/217431 and 10/171610. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter is claimed through slightly different wording.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Esly et al, Schaller, Newbigging, Bjorknas et al, Genise, Ichihasi et al, and Makita. All show gearshift devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley T King whose telephone number is (703) 308-8346. The examiner can normally be reached on 11:00-7:30 M-F.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BTK
June 16, 2003

JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600